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| 09/894,628 | 06/28/2001 | Susumu Nakagawa | 450100-03297 | 6151 |
| 20999 7590 11/09/2007 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER HEWITT II, CALVIN L | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/894,628

Applicant(s)

NAKAGAWA, SUSUMU

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Status of Claims

1. Claims 1-3, 6, 7, 9 and 10 have been examined.

Response to Amendments/Arguments

2. Applicant's arguments with respect to claims 1-3, 6, 7, 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to recite "receiving contents and content usage rights information from a contents distribution server at a memory storage device remote from the user". However, Applicant's Specification is silent "receiving contents *and content usage rights information* from a contents distribution server..." (emphasis added). Applicant discloses two computer configurations for rendering content, figure 1, which depicts a PC (Specification, page 9, lines 5-13) and figure 8, which describes a device which receives data from a remote server and distributes the data to a plurality of local terminals (e.g. PCs, television receivers) (Specification, page 27, lines 5-20). However, neither embodiment teaches receiving content and content usage rights information in response to a request (See also paragraphs 64, 65 of the corresponding published Application). Claims 7, 9 and 10 are also rejected as each recites language similar to claim 1.

Claims 2, 3 and 6 are also rejected as each depends from claim 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. As per claim 1, Applicant has added the language of determining how to convey a warning to a user "based on a predetermined report method in the output setting information". According to claim 1, however, and giving the term its broadest reasonable interpretation (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)), an output setting information is a value (comparing said status code information with *output setting information having a threshold value...*). Therefore, to one of ordinary skill, it is unclear how a single value can comprise multiple values or a computer application such as "a predetermined report method" (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). Claims 7, 9 and 10 are also rejected as each recites language similar to claim 1.

Claims 2, 3 and 6 are also rejected as each depends from claim 1.

b. The term "remote from the user" in claim 1 is a relative term which renders the claim indefinite. The term "remote from the user" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. More specifically, the limitation "remote from the user" speaks to the location of the user. For example, if the user is away from the computer when the warning is received, then the user's PC is a memory storage device that is "remote" from the user. Claims 7, 9 and 10 are also rejected as each recites language similar to claim 1.

Claims 2, 3 and 6 are also rejected as each depends from claim 1.

The following assertion of fact has gone unchallenged and is considered admitted prior art:

- sending content with its corresponding usage information
- distributing information via email

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabin et al., U.S. Patent No. 6,697,948 in view of Venkatesan et al., U.S. Patent No. 6,801,999 and Payton, U.S. Patent No. 5,790,935.

As per claims 1-3, 6, 7, 9 and 10, Rabin et al. teach method and system for managing content comprising:

- Key code monitoring means for comparing usage rights (e.g. number of times or period of time content can be used) with usage status and determining whether content (column 26, lines 32-60) usage is within the range according to content usage information (column 5, lines 8-28 and 35-54; column 59, lines 38-56)
- disabling content if status code information exceeds usage rights (column 5, lines 44-48; column 19, lines 48-57; column 23, lines 15-25; column 59, lines 37-56)
- function for outputting usage status (column 18, lines 55-60)

Rabin et al. disclose content licensing (or usage rights information) (column 59, lines 36-57). Rabin et al. do not explicitly teach transmitting the license (or usage rights information) along with the content. However, to one of ordinary skill this is at least suggested as the computer of Rabin et al. refers to data such as content policy for controlling content (column/line 47/45-48/8) which is typically found in a license. Sending a license (or usage rights information) with its associated content is old and well known, therefore it would have been obvious to one of ordinary skill to send a license with the content wherein the license stores for example, a license expiration date, to enable instant deactivation of content instead of relying on a vendor recognizing that a user has yet to renew her/his license (column 59, lines 36-57). Regarding deleting content, Rabin et al. disclose "punitive measures" (column 23, lines 16-25) as severe as disabling a

computer. Rabin et al. also teach previously installed software with a status such as "removed" (figure 6; column 42, lines 13-23). To one ordinary skill, the prior art at least suggests removing the content from the user computer. Further, it is well known to those of ordinary skill in law to create and receive audit trail of actions performed in order to protect a business [content] owner against possible legal action. Rabin et al. teach distributing usage records to a remote center (column 18, lines 55-60). A well known method for exchanging data over the internet is via email.

According to the MPEP (section 2106, II, C) language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Hence, the outputting of invalidation reports does not distinguish the claims from the prior art, for if content is not disabled or deleted a report is not sent. Rabin et al. do not specifically recite generating a warning code. Venkatesan et al. teach generating a warning code to a user informing the user of actions required to be taken to ensure continued use of a product (column 34, lines 8-29). For example, Venkatesan et al. teach contacting a user via email (column 34, lines 9-29). Therefore, the prior art teaches or at least suggests accessing and displaying the warning email using a PC. However, neither Rabin et al. nor Venkatesan et al. teach "receiving contents and content usage rights information from a contents distribution server in response to a user request at a

memory storage device remote from the user". Payton teaches receiving contents from a contents distribution server at a memory storage device remote from the user (figure 1; column 4, lines 45-54; column 6, lines 20-50; column/line 7/60-8/25; column/line 9/60-10/20). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Rabin et al., Venkatesan et al. Payton to allow multiple users in a home to access content along the same network connection ('935, figure 1) and to remind each user to send a call-up message in order to avoid punitive measures such as disabling of a user computer ('948, column 23, lines 16-25).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

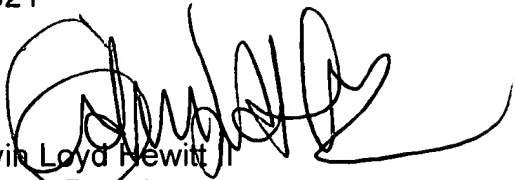
9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Calvin Loyd Hewitt
Primary Examiner

October 30, 2007